Court of Appeals, Federal Circuit In re Gulack No. 82-580

Decided Mar. 30, 1983

PATENTS

1. Patentability — Anticipation — In general (§51.201)

Patentability — Invention — In general

Patentability - Subject matter for patent monopoly Printed matter

obviousness; under Section 103, Board of Aping 1952 Patent Act, employing point of novelmatter rejection is based on case law antedatinvention was suggested by prior art; printed tion and prior art or about whether that and logical footing; standing alone, descripder Section 103 stands on questionable legal printed matter; "printed matter rejection" unart cited against it cannot be ignored merely must read as whole. mutilated claim to be unpatentable; claim ter from it, and declare remaining portion of claim be viewed as whole in determining that approach through its requirement that ty approach; 1952 Act legislatively revised tells nothing about differences between invention of element of invention as printed matter because those differences reside in content of peals cannot dissect claim, excise printed mat-Differences between invention and prior

2. Patentability — Anticipation — In general (§51.201)

Patentability - Invention - In general

Patentability - Subject matter for pat-(§51.611) ent monopoly -Printed matter

although printed matter must be considered, in that situation it may not be entitled to tion from prior art in terms of patentability; patentable weight. ated to substrate does not distinguish inven-Printed matter that is not functionally re-

Patentability — Anticipation — In general (§51.201)

Patentability - Invention - In general (§51.501)

Patentability - Subject matter for patent monopoly -(§51.611) Printed matter

cific functional relationship, without further analysis, is not dispositive of obviousness; claims and prior art sufficient to establish substrate - is not required; what is required of substrate, or conveying information about substrate. ists any new and unobvious functional relarather, critical question is whether there expatentability; bare presence or absence of speis existence of differences between appealed In re Miller, 164 USPQ 46, — to size or type matter and substrate of precise type found in tionship Functional relationship between printed between printed matter and

Particular patents - Mathematical Device

Ring or Concentric Rings, rejection of claims Mathematical Device in the Form of a Band, 1-4 and 6 reversed. Gulack, Educational and Recreational

Serial cuit Judge, dissenting with opinion. applicant appeals. Reversed; Friedman, Cir-From decision rejecting claims 1-4 and 6, No. 935,183, filed Aug. 18, 1978

Before Friedman, Baldwin, and Smith, Circuit Judges.

Smith, Circuit Judge.

tion serial No. 93,183, filed August 18, 1978, entitled "Educational and Recreational Appeals sustaining the rejection under 35 U.S.C. §103 of claims 1-4 and 6 of applica-Mathematical Device in the Form of a Band King or Concentric Rings." We reverse. U.S. Patent and Trademark Office Board of This is an appeal from the decision of the

all prime numbers larger than 5, P, to create the semblance of magic or to educate The stated object of the disclosed invention

Board of Appeals. Appeal from Patent and Trademark Office

as any prime number (an integer not divisible without remainder by any number except itself and unity) greater that 5. E.g., 7, 11, 13, etc. The variable P is defined in the specification

Application for patent of Max A. Gulack

C. Bruce Hamburg, New York, N.Y., for appellant.

John W. Dewhirst (Joseph F. Nakamura and Fred E. McKelvey, on the brief) for U.S. Patent and Trademark Office.

is extremely simple. The appealed claims recite three key elements: (1) a band, ring, or set of concentric rings; (2) a plurality of algorithm by which the appropriate digits are ring at regularly spaced intervals; and (3) an individual digits imprinted on the band or The physical configuration of the invention

device or utensil, jewelry, and other artifacts border, necklace, ring, table edge, household include a belt, hatband, headband, skullcap forth in the specification and appealed claims rial. Specific embodiments of the invention set endless loop of paper, fabric, or plastic matebeginning or end. The band is preferably an digits as an endless sequence with no discrete ports the sequence of digits and it presents the The digits are integers, generated by the The band 2 serves two functions: it sup-

algorithm, and displayed at equal intervals on the outer surface of the band.

The algorithm for generating Q, the sequence of digits imprinted on the band, is also set forth in the specification.

A row of P-1 nines is always divisible by

divisible by P to give an integral quotient P to give a quotient Q which is an integra Whenever a smaller number of nines is

*** It will be found that the number of digits in the quotient Q will always be P-1 or some integral fraction of P-1. ***

an integer greater than 1.

may be designated as P-1/n in which n is integral fractional part of P-1 nines, which Q, the nunmber will always consist of some

nature. Second, the number of digits in al purposes. First, the digits have a "cyclic" ties of the sequence of digits Q, subject to manipulation for recreational or education-The specification describes three quali-

> of digits appearing in sequence in Q. For the prime P will fix the maximum number

original number of digits as aforesaid, will cyclic variation of Q or any multiple of any cyclic variation of Q, if reduced to the more than once. never contain any sequence of any 2 digits more than once. * * * [I]f P is 2 digits, Q or any multiple of Q, or

Finally, the digits of Q are subject to manipulation in accordance with procedures set forth the specification to produce a series of

enough to be readily imprinted on the band. The MAGIC RING OF HAYIM, constructtient Q (derived from P = 181), because its capable of manipulation as set forth in the ed in accordance with the appealed claims, is to the manipulation of the band yet short specification to perform magic tricks or to length is sufficient to lend mystical qualities Appellant recommends the 180 digit quo-

display various aspects of number theory. The appealed claims read as follows:

of zeros necessary to increase the number of digits in said quotient to P-1/n, n being so selected that P-1/n nines is the miniconstituted of P-1/n nines, in which P is a prime number greater than 5 and n is an said quotient is an intergral [sic] number. mum number of nines divisible by P so that lefthand end of said quotient any number integer at least 1, by P and adding to the quotient obtained by dividing a number tively clockwise as a number constituting a imprinted on the band at regularly spaced ends thereof fastened to form an endless band and a plurality of individual digits band which is endless or adapted to have ematical device comprising at least one intervals, the digits when all read consecu-1. An educational and recreational math-

Device according to claim 1, in which

said band is endless.

said band comprises an article of apparel 4. Device according to claim 3, in which Device according to claim 1, in which

Device according to claim 1 in which band is an article of jewelry.

said band is part of a hat or cap.

two grounds: as not directed to statutory subject matter, 35 U.S.C. §101; and as unpatentable over Wittcoff, 35 U.S.C. §103. The The examiner rejected claims 1-4 and 6 on

the starting position has merely shifted.

The sequence of digits is the same in each number;

then Q = 142,857, and 2Q = 285,714.

(Note that in accordance with the specification, (P-1) ÷ n = 6, where n = 2, and P = 13.)

To simplistically illustrate this cyclic feature:

by 13 that yields an integral quotient is 6, thus $Q = 999,999 \div 13$ or Q = 76,923.

If P = 7 (a prime greater than 5); then $Q = 999,999 \div 7$; that is Q = 142,857. If P = 13, the smallest number of nines divisible

concentric rings.
To illustrate:

² As stated by appellant in his specification, band is intended to mean a band, ring, or set of

facture covered by 35 U.S.C. §101. ing that the claims define an article of manuboard reversed the section 101 rejection, find-

strate. In doing so, we do not interpret the

board felt that there is no functional relation

define over Wittcoff. printed matter can not impart a patentable feature to a claim." Applying Parker v. Flook,' the examiner viewed applicant's digdigits are printed. The examiner cited In Re Miller 6 for the proposition that "[m]ere cept that the band is the surface on which the ship between appellant's digits and band exstated that the appealed claims differed from the band. The examiner found no relationits as well known and unable, therefore, to Wittcoff only in the specific digits printed on In his section 103 rejection, the examiner

> possible ambiguity of the board's articulation matter, to its decision not to accord the printed matter patentable weight. Because of the the printed matter as non-statutory subject of a functional relationship, or of the status of thority in analyzing the relevance of the lack tory subject matter. The board cited no aube ignored because it, by itself, is non-statuboard as holding that the printed matter can ship between the printed matter and the sub-

digits and the band of the type indicated found no meaningful relationship between the the court in Miller. In affirming the 103 rejection, the board ьy

appellant's indicia and the claimed endless meaningful functional relationship between printed indicia claimed herein [convey] no substrate [they are] arranged on, [do] not require any size relationship of the sub-Unlike the fact situation in Miller, the tion. We are convinced that there is no substrate to effectively convey the informastrate, and [do] not require any particular meaningful information in regard to the

reasons [sic] to give patentable weight to the content of the printed matter which, uself, is non-statutory subject malter. strate, as we have noted above, there is no tionship of the printed material to the subclaimed by appellant and the sole difference its printed thereon is the same structure Accordingly, there being no functional relais in the content of the printed material formed by the hatband with numerical dig-* * * In our opinion, the endless loop

The rejection of claims 1 to 4 and 6 under 35 USC 103 is sustained. [Emphasis

printed matter patentable weight because the We understand the board as not giving the

differences between the invention and the prior art or about whether that invention was suggested by the prior art. A printed matter rejection is based on case law antedating the 1952 patent act, employing a point of novelty approach. In re Sterling, 70 F.2d 1910, 21 USPQ 519 (CCPA 1934). The 1952 act legislatively revised that approach through its requirement that the claim be viewed as a whole in determining obviousness. Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966). The CCPA has considered all of the limitations of the claims including the printed matter limitations, in determining whether the invention would have been obvious. See In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974); In re Cavrich, 451 F.2d 1091, 172 USPQ 121 (CCPA 1971). In Royka, 490 F.2d at 985, 180 USPQ at 583, the CCPA, notably weary of reiterating this point, clearly stated that printed matter may well constitute. stands on questionable legal and logical footing. Standing alone, the description of an element of the invention as printed matter tells nothing about the content of the printed matter.8 Under section the prior art cited against it cannot be ignored distinction. of its holding, we feel compelled to clarify the whole." If the board meant to disregard that be unpatentable. The claim must be read as a remaining portion of the mutilated claim to merely because those differences reside in the the printed matter from it, and declare the 103, the board cannot dissect a claim, excise structural limitations upon which patentability can [1] Differences between an invention and "printed matter rejection" under §103

be predicated 35 U.S.C U.S.C. §103 (1976) specifically provides

matter as a whole would have been obvious at the differences between the subject matter sought to be time the invention was made to a person having patented and the prior art are such that the subject "A patent may not be obtained * * * if the

(noting the \$103 requirement of reading claims as a whole and extending that requirement to \$101); Diamond v. Diehr, 450 U.S. 175, 188, 209 USPQ 1, 9 (1981) (also applying that requirement in a \$101 setting); Royka, 490 F.2d at 985, 180 USPQ at 583. ordinary skill in the art to which said subject matter pertains. * * * (Emphasis supplied.)
See Graham, 383 U.S. 1, 148 USPQ 459; Flook, 437 U.S. at 594 n.16, 198 USPQ at 199 n.16

(CCPA 1969). Parker v. Flook, 437 U.S. 584, 198 USPQ 193 inside of the hat. "In re Miller, 418 F.2d 1392, 164 USPQ 46

aperture. When an inquiry on the outside of the band is aligned with the aperture, the correspondto align any specific area of information with the aperture at the base of the crown through which an

area of the band is viewed. The band can be rotated ing information printed in areas around both the inside and outside of the band. The hat has an

ing answer is vicwed through the aperture from the

(1978)

⁵ E. Wittcoff, U.S. patent No. 2,796,680, issued June 25, 1957, for "Novelty Educational Hats." Wittcoff discloses a hat with an endless band hav-

217 USPQ

must reverse the rejection as a matter of law. principle of claim interpretation, we

construe and apply Miller within the context of a section 103 rejection, we find no error in the board's articulation of the law. Where the This, apparently, was the board's conclusion with respect to Gulack's invention. may not be entitled to patentable weight. matter must be considered, in that situation it distinguish the invention from the prior art in terms of patentability." Although the printed printed matter is not functionally related to the substrate, the printed matter will not [2] If, instead, the board sought only to

close or suggest the subject matter recited in Gulack's invention are functionally related to the band, and because Wittcoff fails to disthe appealed claims, considered as a whole, However, because we find that the digits of

The sole issue is whether the board correctly affirmed the rejection of the appealed claims as obvious in view of Wittcoff under 35 U.S.C. §103.

The board, responding to appellant's arguments based on In re Miller," found no functional relationship of the type present in

quired cooperative structural relationship necessary before the printed matter can be given patentable weight."12 a measuring device for use in fractioning affirmance of the rejection of claims drawn to was specified. The rejection in Miller was on the basis that the invention lacked "the rerecipes. No statutory ground for the rejection The CCPA 13 responded, stating:14 Miller involved an appeal from the board's

here is not structural but functional relationship * * * * * * [i]t seems to us that what is significant

printed matter," we note that the examiner the indicia and legend as "unpatentable As for the examiner's characterization of

Miller, 418 F.2d 1392, 164 USPQ 46.
II Id.
II Id. 1395, 164 USPQ at 48.

of printed matter as "unpatentable" is bematter, in an article of manufacture claim, can be given "patentable weight." He did and in our judgment the appealed claims properly define this relationship. *** fact that printed matter by itself is not patentable subject matter, because nonmade to patent printed matter as such. The side the point; no attempt is here being so in allowing claims. His characterization volume, and a legend indicating the ratio cating volume in a certain ratio to actua receptable, volumetric indicia thereon indi-Here there is a new and unobvious funcstatutory, is no reason for ignoring it when himself recognizes the fact that printed tional relationship between a measuring the claim is directed to a combination

rejection. the volume measuring device and reversed the Miller's invention was functionally related to The court found that the printed matter of Emphasis in original.

[3] Similarly, in examining Gulack's invention, we find that a functional relationship does exist between the printed matter and the quired. What is required is the existence of differences between the appealed claims and substrate. A functional relationship of the to size or to type of substrate, or conveying precise type found by the CCPA in Miller strate.15 With these thoughts in mind we turn pealed claims in light of the cited reference Wittcoff. now to examine the obviousness of the apship between the printed matter and the subany new and unobvious functional relationthe critical question is whether there exists ysis, is not dispositive of obviousness. Rather, ity. The bare presence or absence of a specific functional relationship, without further analthe prior art sufficient to establish patentabilinformation about substrate — is not re-

cord that printed matter patentable weight. matter. The board declined, however, to acdifference between the appealed claims and Wittcoff resides in the content of the printed Appellant and the board agree that the sole

matter to a band. The printed matter suggestto memory, such as addition, subtraction ed by Wittcoff is data that is to be committed Wittcoff discloses the application of printed

> is for purposes of support and display. The data must be imprinted on the band so that the answer to the inquiry displayed on the outer surface of the band is visible when viewed from inside the hat through the aperother data entries on Wittcoff's band. The ticular sequence. ture. Wittcoff discloses an endless band, relationship of the Wittcoff data to the band independent, bearing no direct relation to the multiplication, history dates, historical personages, and the like. The data items are Wittcoff band are not arranged in any parhe areas of printed matter displayed on the

the band each digit residing in a unique position with ways: (1) the band supports the digits; and require a particular sequence of digits to be respect to every other digit in an endless loop. (2) there is an endless sequence of digits — These digits are related to the band in two Thus, the digits exploit the endless nature of lisplayed on the outside surface of a band The appealed claims, on the other hand,

nor suggests either feature. vation of that sequence of digits. These feaclaims and Wittcoff reside in appellant's parthe appealed claims. Wittcoff neither discloses ticular sequence of digits Q, and in the deriures are critical to the invention disclosed by The differences between the appealed

We reject the board's conclusion that there is no functional relationship between the and it is different from the relationship exhib-ited by the corresponding elements of the Wittcoff reference. We find no suggestion in printed matter and the substrate of the apthe cited reference of appellant's particular sequence of digits Q or of the derivation of pealed claims. Such a relationship does exist hat sequence. Reversed

as obvious under section 103. taining the rejection of the claimed invention Friedman, Circuit Judge, dissenting.

I would affirm the Board's decision sus-

are imprinted numbers in a particular sequence derived from the application of an algorithm. Subordinate claims describe the device," namely, an endless band upon which band as an article of apparel, part of a hat or educational and recreational mathematical The appellant's primary claim is for "[a]n

cap, or an article of jewelry.

The algorithm is not patentable and "is treated as though it were a familiar part of

developing algorithms and applying their product for educational or recreational purposes, it would have been obvious to apply the algorithm by displaying the result of its soluthe practical application of those numbers may be patentable. See In re Meyer, 688 F.2d 789, 215 USPQ 193 (CCPA 1982); In re Abele, 684 F.2d 902, 214 USPQ 682 (CCPA 1982). The issue under section 103 is affirmatively. correctly disclosed in his patent application. The Board tion on a continuous band, as the appellant whether, to one of ordinary skill in the art of produced by an abstract solution of the algorithm cannot themselves be claimed, although the prior art." Parker v. Flook, 437 U.S. 584, 592 (1978). Similarly, the particular numbers answered that question

appellant's subordinate claims displays the produced for appellant's purposes, to display them on a continuous band. Indeed, one of the numbers on a hat or cap. who wanted to use the numbers the algorithm are differences between the display of numhatband to display numbers as an "education-al or game-playing device." Although there Wittcoff for one of ordinary skill in the art bers in appellant's invention and their display in Wittcoff, it would have been obvious from The Witcoss patent teaches the use of a

to anyone of ordinary skill in the art who continuous series-would have been obvious cance—the arrangement of the numbers as a numbers are placed is thus of little importance. The only matter that is of signifiupon a cube or other shape, or even by writing them in a circle upon a flat surface. tion accomplishes also could be accomplished claimed. In fact, at oral argument the appel-lant conceded that the same result his invenon an "endless band" as the appellant tinuous series. They do not need to be placed claims merely by arranging them in a concoff. The numbers can be used for the recreaa series without a particular beginning or end The precise nature of the object on which the by placing the numbers in a continuous series tional and educational purposes the appellant would have been obvious even without Wittother object that permits them to be shown in The display of the numbers on a band or

tions and legends on them. In the present case, unlike Miller, I do not think that the "functional relationship" between the numbers regulting from the configuration of the court determined that there was "a new and unobvious functional relationship" between In In re Miller, 418 F.2d 1392, 164 USPQ 46 (CCPA 1969), as the court points out, the the measuring receptacles and the descripknew the algorithm.

¹⁷ The holdings of the United States Court of Customs and Patent Appeals and of the United States Court of Claims were adopted as precedent in the Court of Appeals for the Federal Circuit in South Corp. v. United States, 690 F.2d 1368, 1370, 215 USPQ 657, 658 (Fed. Cir. 1982).

¹⁶ Miller, 418 F.2d at 1396, 164 USPQ at 48-

217 USPQ

algorithm and their display upon the continuous band was new and unobvious.

Ronald S. Rosen, defendants. Los Angeles, Calif., for

Before Anderson, Circuit Judges. Pregerson, and Nelson,

Anderson, Circuit Judge.

dants' motion for summary judgment and dismissed the other claims. We affirm. misappropriation, and breach of implied contract. Mrs. Jason's primary allegation was that the defendants' motion picture, Coming copyright infringement, unfair competition novel, Concomitant Soldier - Woman and War. The district court granted the defen-Home, infringed on the copyright in her Jane Fonda and eight other defendants for Sonya Jason brought an action against

Court of Appeals, Ninth Circuit

Jason v. Fonda, et al.

Decided Feb. 8, 1983 No. 81-5973

leads us to concur in the well-reasoned decision of Judge Kelleher filed September 21, 1981. 526 F.Supp. 774, 217 USPQ 231 (C.D. Cal. 1982). We therefore incorporate his memorandum of decision by reference. Judge Kelleher aptly points out: [1,2,3] Our review of the facts and issues

defendants has access to her work. Such a showing is insufficient to create a genuine issue of material fact. See British Airways Board v. Boeing Company, 585 F.2d 946, 952 (9th Cir. 1978), cert. denied, 440 U.S. 981 (1979); (1) Mrs. Jason presented evidence showing no more than a "bare possibility"

(2) Even assuming access, there was no sion Productions, Inc. v. McDonald's Corp., 562 F.2d 1157, 196 USPQ 97 (9th Cir. 1977); and works under the standards announced by substantial similarity between the two this court in Sid & Marty Krofft Televi-

established if there is no substantial similarity

between two works.

cess to author's work, intringement is not

Even assuming alleged infringers had ac-

3. Pleading and practice in courts - Dis-

missal of suit (§53.33)

when federal claim is dismissed prior to trial

It is proper to dismiss pendent state claims

2. Infringement — Evidence of (§24.205)

sibility" that alleged infringers had access to author's work is insufficient to create issue of

Evidence showing no more than "bare pos-

1. Infringement — Evidence of (§24.05)

(3) It is proper to dismiss pendent state claims when the federal claim is dismissed prior to trial. Wham-O Mfg. Co. v. Paradise Manufacturing Co., 327 F.2d 748, 753, 140 USPQ 357, 361-362 (9th Cir. 1964); see also, Wren v. Sletten Construction Co., 654 F.2d 529, 536 (9th Cir. 1981).

his discretion in handling discovery nor in denying Mrs. Jason's motion for Additionally, Judge Kelleher did not abuse

The appellees' request for sanctions and attorney's fees is denied. Single costs are allowed. reconsideration.

Action by Sonya Jason, against Jane Fonda, Bruce Gilbert, Jerome Hellman, JPL Production, Inc., United Artists Corporation, National Broadcasting Company, Inc., Nancy Dowd, Robert C. Jones, and Waldo Salt, for

Appeal from District Court for Central District of California, Kelleher, J.; 217

AffirmedThe judgment of the district court is

tract. From order granting summary judg-ment for defendants, plaintiff appeals. misappropriation, and breach of implied concopyright infringement, unfair competition,

Affirmed.

UNFAIR COMPLETION

v. Forum International, Ltd. et al

propriating her right of publicity.

Accounting — Parties liable (§11.45)

zine is liable to celebrity for wrongfully al

truth, advertisements which implied that co

Nos. 82-5106 and 82-5107 Decided Nov. 18, 1982

Court of Appeals, Ninth Circuit

1. Miscellaneous cases (§68.65)

headlines and promotional devices were true or were not published with knowledge that they were false or in reckless disregard for use of headlines and cover display, so long as ment; this protection extends to magazine's public figure is protected by First Amend-Magazine's publication of interview with

2. Miscellaneous cases (§68.65)

California law permits recovery for un-authorized use of one's likeness or name for der this theory will lie solely for publication commercial purposes; however, no action unwhich is protected by First Amendment.

3. Miscellaneous cases (§68.65)

ful use of public figure's name and likeness in advertising which is merely adjunct of procd publication. tected publication and promotes only protect Constitutional protection extends to truth-

4. Miscellaneous cases (§68.65)

actionable under appropriation of publicity theory so long as advertising does not falsely claim that public figure endorses that news Advertising to promote news medium is not

5. Miscellaneous cases (§68.65)

scription advertising for purpose of indicating content of publication in which she was interviewed; such usage is protected by First Magazine is entitled to use public figure's picture and to refer to her truthfully in sub-Amendment.

6. Miscellaneous cases (§68.65)

she had intended to give interview to rival zine that published it, is not protected magazine, and had not told anything to magawould never tell rival magazine, when in fact First Amendment. Magazine that falsely claims in its adver-tisements that celebrity told it things she

7. Miscellaneous cases (§68.65)

zine that published, with knowledge that they First Amendment does not protect maga-

Miscellaneous cases (§68.65)

zine, and that participated in preparation by the advertisements. magazine to share magazine's liability to pul lic figure whose celebrity value was exploite participated sufficiently in false advertising (advertisements which appeared in magazin Company that owns 80% of stock of maga

Accounting — Damages — Trademarl and unfair competition (§11.258)

exemplary damages. liable to celebrity for general, special, an vertising and promotional misrepresentation that exploited celebrity's publicity value lebrity's right of publicity by using false ac Magazine that wrongfully appropriated or

District of California; Real, J., 213 USP Appeal from District Court for Centra

of right to publicity, and violations of Lar ham Act. From order granting judgment for plaintiff, defendants appeal. Affirmed in par Group Publications, Inc., doing business a the Star, and Fred Robbins, for breach of zine, Penthouse International, Ltd., New modified in part, and reversed in part. tion of name and likeness, misappropriatio contract, unfair competition, misapproprie Action by Cher, against Forum Interna

John D. Forbess, and Rubin, Perlstein & Chieffo, both of Beverly Hills, Galif., for plaintiff.

Douglas C. Conroy, and Paul, Hastings, Jar. ofsky & Walker, both of Los Angele. Calif., and Roy Grutman, and Grutman \(\) rum International Ltd. and Fred Robbins Miller, both of New York, N.Y., for Fc

Louis P. Petrich, and Youngman, Hungate & Leopold, both of Los Angeles, Calif., fo